

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application:

LUKAS-LASKEY et al.

Serial Number: 08/875/603

Filed: August 4, 1997

For: USE OF CARBAZOLE COMPOUNDS FOR THE TREATMENT OF
CONGESTIVE HEART FAILURE

DECLARATION OF DR. MANFRED WEBER

Assistant Commissioner

of Patent

Washington, D.C. 20231

Manfred Weber deposes and states as follows:

1. I am a European Patent Attorney employed in the Patent Department of Boehringer Mannheim GmbH.
2. The above-identified application is owned by Boehringer Mannheim Pharmaceuticals Corporation SmithKline Beecham Corporation Limited Partnership No. 1, a partnership between SmithKline Beecham Corporation and the Boehringer Mannheim Group. The Patent Departments of SmithKline Beecham and Boehringer Mannheim are assisting the partnership in its patent activities.
3. On February 8, 1995, I caused the filing of German patent application no. 195 03 995.5. Some while after the German application was filed, I submitted an Identification of Inventors, which inventors are the same as in the above-identified U.S. patent application.

On June 7, 1995, the Patent Department of Smith Kline Beecham submitted a U.S. application S.N. 08/483,635 claiming the benefit of the filing date of the above-identified German application. A foreign filing license was granted on December 21, 1995. Subsequently, further filings in other countries occurred.

4. Subsequent to the above, I filed an PCT International Application on February 7, 1996. The front page of the corresponding published application is attached, from which it will be noted that the German and U.S. applications identified above are claimed for priority purposes.

5. When I filed the above-identified German application, I did not consider the fact that U.S. inventors may be involved, and thus did not consider the question of obtaining a foreign filing license from the U.S. Patent and Trademark Office. In a meeting in the office of U.S. counsel on December 1-2, 1995, the question of a foreign filing license arose, and the decision was made to file the accompanying Request for a Retroactive Foreign Filing License. At this point, I first realized that I should have obtained a foreign filing license from the U.S. PTO before filing the German patent application mentioned above.

6. I now realize that I should have explored the issue of whether a U.S. inventor was involved, such that a part of the invention was made in the United States, and if so should have requested a foreign filing license prior to the filing of the subject German application. I have taken careful note of this requirement, and have brought this matter to the attention of all other members of the Patent Department of Boehringer Mannheim GmbH, in an effort to prevent further inadvertent foreign application filings without required filing licenses from the U.S. Patent and Trademark Office.

There were no other filings in foreign countries of the subject matter of the German application until after the foreign license was granted on December 21, 1995.

The subject matter of the German patent application was not under secrecy order at the time it was filed in Germany, and it is not currently under a secrecy order.

7. In view of the fact that foreign license requirement was only brought to my attention on December 1, 1997, and that this declaration has been promptly prepared thereafter, it is clear that the filing of the accompanying Request in this application is diligently made.

8. The filing of the German application without a U.S. foreign filing license was through an error on my part, and was without deceptive intent.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



Dr. Manfred Weber

Date: Dec. 10, 1997

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